REMARKS

Claims 1-11 are pending in the present application. Claims 1 and 11 are independent. Claim 11 is added. No new matter is involved.

Reconsideration of the Application on the basis of the following remarks is respectfully requested.

Claims 6-9 stand rejected under 35 USC §112, first paragraph for lack of enablement. This rejection is respectfully traversed.

In the first place, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of lack of enablement.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See, United States v, Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert, denied, 109 S.Ct. 19 54 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976). As framed by our reviewing court, the dispositive issue with regard to the first paragraph rejection is whether the disclosure is sufficient to enable one of ordinary skill in the art to practice the claimed invention. See, Lindemann Machinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed

invention. See, In re Wright, 999 F.2d 1557, 1561-2, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).(Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 USC 112, first paragraph unless there is a reason for doubting the objective truths of the statements contained in the disclosure which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make or use will be proper on that basis. See, In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

Once the Examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement [the appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the

disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR 1.132 or cite references to show what one skilled in the art knew at the time of filing the application] against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the applicant's disclosure, considering the level of skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. The threshold step in resolving this issue is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.

Factors to be considered by an Examiner in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of guidance or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See, In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), citing Ex parte Formal, 230 USPQ 546, 547 (Bd. Pat, App. & Int. 1986).

Moreover, a rejection based on Sections 101, 102 or 103 must rest on a factual basis. An examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is

patentable for lack of compliance with a statutory basis, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, Compare, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The Office Action fails to present any objective evidence of lack of enablement. Instead, the rejection is wholly founded on speculation, instead of on a factual basis supported by objective evidence.

The Office Action speculates that the specification does not adequately describe what the "adjustment coefficient" is, how it is derived, or why it is used and, accordingly, one of ordinary skill in the art would not know how to use the invention with respect to this feature.

Applicants respectfully disagree.

The specification, on pages 15 and 16, clearly discloses that controller 20 calculates a monitor width Cw by multiplying the standard deviation Es of the molding data Da, etc., within the sampling zone Zs by an adjustment coefficient Ki, in step S9. The monitor width is defined as Cw = Es x Ki. The specification continues by stating that the monitor width can be obtained by multiplying a variation coefficient U by an adjustment coefficient Kj, where the variation coefficient can be obtained by dividing the standard deviation Es of the molding data Da, etc., within the sampling zone Zs by the average of the molding data Da, etc. within the sampling zone Zs. This is expressed by the equation: Cw = U x Kj = (Es/Xs) x Kj.

The specification then indicates that, in either case, the adjustment coefficient Ki or Kj is set to assume the optimum value for each monitor item (Ra, etc.).

Thus, the Application discloses two types of adjustment coefficients with mathematical precision. Applicants believe that this is sufficient guidance to one of ordinary skill in the art, who is presumed to be fully conversant with statistical analyses as applied to injection molding machines and is used to keeping the molding machines operating to achieve acceptable molded products. In general, adjustment factors traditionally adjust injection molding process control parameters (monitored items) to reduce a molded product's deviation from normal, desired values, based on detected deviations from normal.

Applicants believe that they have provided adequate guidance to skilled injection molding professionals to make and use the invention, and that the Office Action fails to take into consideration the disclosure found on pages 15 and 16 of this Application, the skill level of those of ordinary skill in the art, and the fact that adaptive control of injection molding is well known and highly advanced.

The Office Action fails to address any of the eight Wands factors in any detail whatsoever, let alone to indicate why this detailed mathematical disclosure is insufficient to enable one of ordinary skill in the injection molding art to make and use the same.

Reconsideration and withdrawal of this rejection is respectfully requested.

REJECTION UNDER 35 USC §102(b)

Claims 1, 2, 5 and 10 stand rejected under 35 USC §102(b) as anticipated by U.S. Patent 5,301,120 to Magario. This rejection is respectfully traversed.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478,1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.

Claims 1, 2, 5 and 10 recite, among other features, "displaying the detected actual values on a screen of a display in such a manner that a distribution of the actual values can be visually grasped; designating a sampling zone for the displayed actual values in such a manner that a portion of the displayed actual values are contained in the sampling zone; and automatically setting the determination condition on the basis of actual values contained in the sampling zone."

In the first place, Magario does not designate a sample zone from the displayed actual values. Instead, Magario determines a sample range and then displays that sample range. Once the sample range is displayed, Magario makes no further designation of a zone or range.

In the second place, Magario does not automatically set the determination condition used for determining whether a molded product is non-defective or defective on the basis of actual values contained in the sampling zone. Instead, Magario uses computer 12 to do number of things off-line. There is no disclosure in Magario of "automatically setting" anything, let alone "automatically setting the determination condition on the basis of actual values contained in the sampling zone," as recited.

Moreover, not only is there no explicit disclosure of such features in Magario, but also there is no inherent disclosure of them, either.

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749(Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597,

1599(Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Accordingly, the Office Action does not demonstrate a prima facie case of anticipation of the claimed invention recited in claims 1, 2, 5 and 10 by Magario.

Reconsideration and withdrawal of this rejection is respectfully requested.

NEW CLAIM 11

Applicants have added claim 11, which finds adequate support in the originally filed application, for example, in the originally filed claims and in the main body of the specification on pages 13-15.

This claim recites a combination of features including visually grasping a distribution of the displayed actual values; and designating a sampling zone for the displayed actual values in such based on the visually grasped distribution to contain a portion of the displayed actual values in the sampling zone, neither of which are disclosed or suggested by Magario.

Accordingly, Applicants respectfully submit that claim 11 is patentable with respect to the applied art.

ADDITIONAL CITED REFERENCES

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 39,538, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Pursuant to the provisions of 37 C.F.R. § 1.17 and § 1.136(a), Applicant hereby petitions for an extension of one (1) month in which to file a response to the outstanding Office Action. The required fee of $120.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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